

REMARKS

In accordance with the foregoing, the specification and claim have been amended.
Claim has been cancelled.

Claims 1-30 are pending and under consideration.

REJECTION UNDER 35 U.S.C. § 102:

In the Office Action, at page 2, claims 1, 4, 5, 7-9, 11-13, 16-18, 20, 21, 23, 24, and 26-30 are rejected under 35 U.S.C. § 102 in view of U.S. Patent No. 6,393,461 to Okada et al. ("Okada"). This rejection is traversed and reconsideration is requested.

Okada generally provides a user's instruction to an agent in a chat channel to read out a log file, and viewing, by means of a URL received from an agent, a chat log on a Web page that contains a chat log in the past and a chat log the user did not participate in. See FIG. 7 and corresponding description.

However, Okada neither teaches nor suggests, "table means for storing therein identifiers and corresponding character-train information of persons using said virtual communications spaces," as recited in independent claim 1.

Furthermore, Okada is silent as to teaching or suggesting, "search means disposed in said server for searching said table for character-train information," as recited in independent claim 9.

Furthermore, Okada is silent as to teaching or suggesting, "converting means for converting a designated one of said identifiers stored in said memory to a predetermined character train and causing said display means to display the character train," as recited in independent claim 27.

At the time of filing the subject application, the Internet Relay Chat Protocol, Network Working Group, Request for Comments: 1459 ("RFC1459"), developed by the IETF (See <http://www.ietf.org/rfc/rfc1459.txt>, which is hereby submitted in an Information Disclosure Statement filed concurrently with the present Amendment) was known, and explains the following: "Each client is distinguished from other clients by a unique nickname having a maximum length of nine (9) characters" (1.2 Clients).

Thus, a unique nickname consists of nine characters. Individual clients are

conventionally identified only by their nicknames, and hence different nicknames cannot be assigned to respective channels.

More importantly, the RFC1459 neither describes nor suggests, “table means for storing therein identifiers and corresponding character-train information of persons using said virtual communications spaces,” as recited in claims 1. Thus, the RFC1459 neither describes nor suggests “search means disposed in said server for searching said table for character-train information corresponding to the identifier of a message sender when said server receives said identifier and a message from said message sender,” as recited in independent claim 9. The RFC1459 neither teaches nor suggests, “converting means for converting a designated one of said identifiers stored in said memory to a predetermined character train and causing said display means to display the character train,” as recited in independent claim 27. Neither such a table nor converting means was known or implied in any documents at the time of filing the subject application.

"Anticipation requires the presence in a single prior art reference the disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GMBH v. American Hoise and Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984). Thus, the Patent Office has the burden of making out a prima facie case, which requires it to produce the factual basis for its rejection in an application under §102. Rather than showing in a single prior art reference all the recitations of independent claim 1, the Office Action relies on inherency to arrive to the novel features recited in the claim, which is improper practice under current Patent laws and case law.

The Office Action provides no justification to rely on such inherency theory. Rather, conclusive statements are made such as “a table means for storing identifiers and corresponding character-train information of users is inherently implied in a chat system that has character-train associated with users.” It is respectfully requested that either a reference be provided showing every element of the claimed invention, or that the rejection to the claims be withdrawn.

Because independent claims 9, 12, 13, 18, 21, and 24 include similar claim features as those recited in independent claim 1, although of different scope, and because the Office Action refers to similar portions of the cited references to reject independent claims 9, 12, 13, 18, 21, and 24, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 9, 12, 13, 18, 21, and 24.

Because independent claims 12, 13, 18, 21, and 24 include similar claim features as

those recited in independent claim 9, although of different scope, and because the Office Action refers to similar portions of the cited references to reject independent claims 12, 13, 18, 21, and 24, the arguments presented above supporting the patentability of independent claim 9 are incorporated herein to support the patentability of independent claims 12, 13, 18, 21, and 24.

In view of the foregoing, it is respectfully requested that independent claims 1, 9, 12, 13, 18, 21, 24, and 27 and related dependent claims be allowed.

REJECTION UNDER 35 U.S.C. § 103:

In the Office Action, at page 15, claims 2, 3, 10, 14, 15, 19, 22, and 25 are rejected under 35 U.S.C. § 103 in view of Okada. The rejection is traversed and reconsideration is requested.

The arguments presented above are incorporated herein to support the patentability of claim 2/1, 3/1, 10/9, 14/9, 15/13, 19/18, 22/21, and 25/24 over Okada.

On page 15 of the Office Action, it is acknowledged that Okada fails to teach or suggest the claimed features of dependent claims 6 and 20. Thus, it is conclusively contended in the Office Action that "Okada does not explicitly show said table means contains different character-train information for the identifier of a same one person for use in different ones of said virtual communications spaces. Nonetheless, this feature is well known in the art and would have been an obvious implementation of the system." It is improper to merely deem something obvious without any teaching/suggestion, or the taking of Official Notice along with a signed Affidavit provided by the Examiner of record. "It is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." *See In re Lee* 61 USPQ2d 1430 (CA FC 2002) (citing *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775).

If the U.S. Patent and Trademark Office wishes to take Official Notice that the proposed structural and functional modification is notoriously well known, it is respectfully requested that supporting evidence be provided. The Federal Circuit has cautioned that an Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

While "official notice" may be relied upon, as noted in MPEP §2144.03, these circumstances should be rare when an application is under final rejection or action under 37 CFR §1.113. Official Notice unsupported by documentary evidence should be only be taken by

the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known and only when such facts are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. Further, Applicants should be presented with the explicit basis on which the Examiner regards the matter as subject to official notice sufficient to allow the applicant a proper opportunity to challenge that assertion.

No such showing has been made in the present Office Action. It is submitted that the reason why no such showing was made is because Okada fails to teach, suggest, or otherwise provide the motivation needed to make such a modification. "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness." Ex Parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985).

Thus, Okada fails to teach or suggest all the recitations of independent claims 1, 9, and 17. Accordingly, it is respectfully requested that independent claims 1, 9, and 17 and related dependent claims be allowed.

In the Office Action, at page 17, claim 6 is rejected under 35 U.S.C. § 103 in view of Okada and in view of U.S. Patent No. 5,828,839 to Moncreiff ("Moncreiff"). The rejection is traversed and reconsideration is requested.

The arguments presented above are incorporated herein to support the patentability of claim 6/1 over Okada.

Moncreiff generally provides a chat room system including a main menu where a user can select a default/setup button 132 to invoke a setup screen 150 shown in FIG. 10. See column 8, lines 39-49. The user can indicate his system software by selecting software from a list 152. A welcome screen is also provided.

However, similarly to Okada, there is no teaching or suggestion in Moncreiff of providing "table means for storing therein identifiers and corresponding character-train information of persons using said virtual communications spaces, wherein said corresponding character-train information being used as said message sender identifying information," as recited in independent claim 1. A combination of the cited references would fail to teach or suggest all the recitations of independent claim 1. The combination of Okada and Moncreiff would be silent as to providing the table means and the character-train information being used as said message

sender identifying information recited in independent claim 1.

Accordingly, it is respectfully requested that independent claim 1 and related dependent claims be allowed.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. There being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.


If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner's contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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